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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,216	04/16/2004	John Amico	32798-2003	7252
33721	7590	09/01/2005	EXAMINER AZARIAN, SEYED H	
TORYS LLP 79 WELLINGTON ST. WEST SUITE 3000 TORONTO, ON M5K 1N2 CANADA			ART UNIT 2625	PAPER NUMBER

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,216

Applicant(s)

AMICO ET AL.

Examiner

Seyed Azarian

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 4-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/30/05 & 5/28/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.3218 may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/492,722. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by patent since the patent and application are claiming common subject matter, as follows: receiving at least one data representing at least one shape, identifying at least one outline of the at least one shape in the at least one data, and identifying at least one corner of the at least one outline; a system for digitizing shapes, said system comprising: a) a memory arrangement including thereon a computer program; and b) a processing arrangement which, when executing the computer

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program, is configured to: i) receive at least one data representing at least one shape, ii) identify at least one outline of the at least one shape in the at least one data, and iii) identify at least one corner of the at least one outline. The scope of the claimed invention is fully disclosed in the '722 patent, and the claims of the application are generic compared to the patented claims, which is directed to a specific species.

Claims 4-56 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group two, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/30/2005.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, are rejected under 35 U.S.C. 102(b) as being anticipated by Shimazu et al (U.S. patent 5,379,350).

Regarding claim 1, Shimazu discloses a method of digitizing shapes (column 19, lines 1-8 binary image data);

said method comprising the steps of: receiving at least one data representing at least one shape (column 6, lines 8-14, the shape of the contour represents an arrangement of pixels linked by the contour vectors);

identifying at least one outline of the at least one shape in the at least one data (column 6, lines 45-58, pixel data representing an image with respect to each pixel data, or vector data representing "outlines");

representing an image and identifying at least one corner of the at least one outline (column 6, lines 64-65, detects "vertices" of a contour, generates segment vectors representing segments of the contour);

Regarding claim 2, the arguments are analogous to those presented for claim 1, are applicable. The memory arrangement including thereon a computer program (Fig. 2, element 50-58, column 6, lines 26-30, the apparatus is a computer comprising the CPU including a run-data conversion unit, stored in a main memory).

Regarding claim 3, the arguments are analogous to those presented for claim 1, are applicable. The software program (stored in a main memory 50; column 6, lines 26-30) inherently includes module for instructly the system of claim 2 for receiving data represents the shape, identifying at least one outline and identifying the at least one corner of the at least outline.

#### Other prior art cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(U.S. patent 6,587,745) to Polden et al is cited for curved line fill stitching in embroidery designs.

(U.S. patent 4,780,960) to Merz is cited for pattern, process and apparatus for obtaining a cutting template.

(U.S. patent 5,815,398) to Dighe et al is cited for method and apparatus for placing parts in a bounded region.

(U.S. patent 4,583,181) to Gerber et al is cited for fabric flaw related system.

(U.S. patent 5,831,857) to Clarino et al is cited for pattern alignment and cutting system.

(U.S. patent 4,575,628) to Bankart et al is cited for pattern scanner providing data to a computer, which carries out lay planning.

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Azarian whose telephone number is (571) 272-7443. The examiner can normally be reached on Monday through Thursday from 6:00 a.m. to 7:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached at (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR.

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Status information about the PAIR system, see [http:// pair-direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Seyed Azarian*  
*Patent Examiner*  
*Group Art Unit 2625*  
August 22, 2004

✓   
**DANIEL MIRIAM**  
**PRIMARY EXAMINER**